

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 10/729,096
Filing Date Dec. 05, 2003
Inventorship Samuelsson et al.
Assignee Microsoft Corporation
Group Art Unit 2139
Examiner Nicole M. Young
Attorney's Docket No. MS1-1696US
Title: User Name Mapping

REQUEST FOR A PRE-APPEAL BRIEF CONFERENCE FILED WITH A NOTICE OF APPEAL TO THE FINAL OFFICE ACTION OF AUGUST 31, 2007

To: Mail Stop AF
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

From: Bea Koempel-Thomas (Tel. 509-324-9256; Fax 509-323-8979)
Customer No. 22801

REMARKS/ARGUMENTS

The following remarks are directed to a Request for a Pre-Appeal Brief Conference as set forth in the Official Gazette Notice of 12 July 2005.

Reason for Request

Refusing entry of the Applicant's statement of Obligation of Assignment to the Same Assignee under 35 U.S.C. 103(c) is in clear error. The statement should be entered, since prior art applied under §103(a) which only qualifies under §102 (c), (f), or (g) "*shall not preclude patentability*," (emphasis added, 35 U.S.C. 103(c)(1)). Since the best references should already have been applied, (see MPEP 706.02(l)(3)), claims 1-5, 8-13, and 22-27 should now be patentable.

The rejection of claims 22-27 under 35 U.S.C. 101 is in clear error. The rejections should be withdrawn because the basis for the rejection does not apply the proper standard for patentability under §101, the claims are directed to statutory subject matter, and the claims should be patentable.

In this matter, application of both §101 and §103 are in clear error.

Laws and Rules

35 U.S.C. 103(c)(1) states: "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.116(e) provides: "evidence submitted after a final rejection . . . but before or on the same date of filing an appeal . . . may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

35 U.S.C. 101 states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Procedural Facts

1. On December 5, 2003, claims 1-32 were filed in an original application accompanied by Assignment papers and the proper fees.
2. In an Office Action mailed October 23, 2006, all claims (1-32) were rejected as being anticipated by Willebeek-LeMair et al. U.S. Patent Application Publication 2003/0204632 (pub. Oct. 30, 2003) under 35 USC 102(e).
3. An Office Action Response was filed February 23, 2007, wherein Applicant amended claims 1-3, 5, 14-17, 22, and 28-32; also, wherein Applicant cancelled claims 6-7 and 18.
4. In a Final Office Action mailed May 16, 2007, claims 14-17, 19-21, and 28-32 were rejected as being anticipated by Willebeek-LeMair et al., U.S. Patent Application Publication 2003/0204632 (published Oct. 30, 2003) under 35 USC 102(e), and claims 1-5, 8-13, and 22-27 were rejected as being unpatentable over Willebeek-LeMair in view of Cedar et al. U.S. Patent Application Publication 2003/0236994 (published Dec. 25, 2003).
5. An Examiner Interview was held Aug. 8, 2007.
6. An Office Action Response under 37 C.F.R. 1.116 was filed Aug. 16, 2007, wherein Applicant argued against 35 U.S.C. 101 rejections, amended NO claims, and submitted the necessary statement under 35 U.S.C. 103(c).
7. An Interview Summary was mailed Aug. 16, 2007.
8. In an Advisory Action mailed Aug. 31, 2007, the Office advised that all rejections were maintained, amendments would be entered for purposes of appeal (although no amendments

were submitted), and the §103(c) declaration would not be entered (allegedly) because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

9. An Examiner Interview was held Sep. 25, 2007.
10. A Notice of Appeal is being filed Oct. 16, 2007, with this request.

Facts Supporting Request

In accordance with 35 U.S.C. 103, 35 U.S.C. 101, and 37 CFR 1.116:

Assignment of both the reference and the instant application to Microsoft was of record with the filing of the instant application, thus the Office should have anticipated that the reference would be removed via 103(c), (see MPEP 706.02(I)(3)).

Applicant timely alerted the Examiner of the common assignment and timely filed the §103(c) declaration as part of a Response to Final Office Action under 37 CFR 1.116.

The Office has refused entry of the 103(c) declaration, stating "the Examiner must conduct an updated search and further [sic] consider the prior art of record." (See Advisory Action, Aug. 31, 2007).

The Office maintains the §101 rejection of claim 22: "A system implemented at least in part by a computing device." The Office states "[the claim] does not recite enough structure." (See Advisory Action, Aug. 31, 2007).

Argument

Refusing entry of the Applicant's statement of Obligation of Assignment to the Same Assignee under 35 U.S.C. 103(c) is in clear error. The statement should be entered, since the reference is only available under 35 U.S.C. 102(e). Because the best references should already have been applied, (see MPEP 706.02(I)(3)), these claims should now be patentable. If the Office still does not believe that the claims are patentable, then the Office should bear the burden of reopening prosecution.

Maintaining the final rejections of claims (1-5, 8-13, and 22-27) as being obvious over a combination of references including, Cedar et al. (US Pat. App. Pub. No. 2003/0236994), under 35 USC 103(a) is in clear error because this reference was first cited in the Final Office Action of 8/31/2007, and the Examiner should have anticipated removal of Cedar under §103(c) since it is assigned to the same assignee. Thus, these claims should now be patentable. If further search is

required, then an insufficient search was previously conducted, which in turn indicates that prosecution should be reopened.

The Office refusing entry of the §103(c) declaration under the facts of this case is an arbitrary and capricious decision since prior assignment serves as notice to the Examiner that removal is likely. Applicant appreciates the Examiner's duty to cite the best art, even if commonly assigned; the Examiner also has a duty to remove that art when a proper declaration is submitted as in this case.

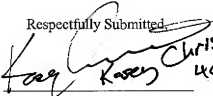
Applicant maintains that since the claims should now be patentable and Applicant had no reason to know that the Office would cite Cedar in the rejection, entering the §103(c) declaration in a Response to Final under §1.116, with a statement that we did not submit the declaration sooner since the commonly assigned art was first cited in a final rejection constitutes good and sufficient reason why the evidence is necessary and was not earlier presented, as provided for in §1.116(e). Furthermore, refusing entry works an injustice upon the Applicant in light of the new rules limits on RCEs. Requiring Applicants to file an RCE to have evidence entered of a status in effect since the original application filing is unreasonable.

Maintaining rejection of claims (22-27) under 35 U.S.C. 101 is in clear error because the standard for patentability under §101 has been met as illustrated in the Applicant's Response under §1.116 filed Aug. 16, 2007, (pp. 15-16, ¶¶ [0020-0025]).

Conclusion

Applicant respectfully requests that the §103(c) declaration be entered, the §101 rejections be withdrawn, and these claims be allowed to issue.

Dated:

Respectfully Submitted,
By:  *Christie*
40,559

Bea Koempel-Thomas
Reg. No. 58,213
Lee & Hayes, PLLC
(509) 324-9256